Remarks

Claims 15-49 are active and pending in the present application. All claims stand rejected. In response, Applicants have provided the following remarks and solicit reconsideration and withdrawal of the rejections. Claim 16 was objected to for depending from claim 1; it has been amended to depend from claim 15. The abstract was objected to for being two paragraphs. Accordingly, a replacement abstract has been provided that is a single paragraph.

Claims 15-49 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-12 of US Patent 6,778,584. Applicants recognize that an appropriate terminal disclaimer may be used to overcome this rejection once it is no longer a provisional rejection.

Claims 15 and 46 stand rejected under 35 USC §102 as anticipated by Osamu (JP 04-314374). The Examiner asserts that Osamu identically discloses every element of claim 15 and specifically discloses that the gas being forced across the grating face is Helium. Applicants urge that Osamu does not identically disclose that Helium is forced to flow across a grating face. The only English portion of Osamu provided is the Abstract which does not mention Helium or any other gas. One portion of Osamu (column 5) identifies a particular type of laser being used such as a He-Ne laser. However, this mention of a type of laser is not sufficient to be considered as identically disclosing that Helium gas is forced to flow across a diffraction grating. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §102 of claim 15 are respectfully requested.

Claim 46 does not specifically identify Helium as the gas being forced to flow across the grating face. However, Applicants urge that when considered in view in the entirety of the surrounding circumstances, Osamu does not identically disclose the invention recited in claim 46. The Examiner must consider the prior art as a whole, including portions, which would lead away from the claimed invention. This principle applies when references specifically disagree with each other. In such a case the Examiner must weigh the suggestive power of each reference to determine what is disclosed to one of ordinary skill. In *In re Young*, 927 F.2d 588, (Fed. Cir. 1991). An earlier reference taught a feature of the claimed invention and a subsequent reference taught that the feature disclosed in the earlier reference would not work. The court held that this

contrary teaching must be taken into account but that the later opinion was not valid, because it was not based on an accurate examination of the earlier disclosed feature.

That deficiency in evaluation of the earlier criticized reference by another party is not the case here. Here the very same inventors of the subject matter of an earlier published patent application (Osamu '374) abandoned that patent application and filed for and obtained a patent (Osamu JP 5-167172) on a technique totally contrary to that proposed in the published application ('374). So, the later filed contrary disclosure (Osamu '172) issued as a patent and the earlier filed application (Osamu '374"), filed in 1991, has not issued as a patent.

Applicants submit that these facts place in the record information, which the Examiner must use to weigh the suggestive power of each of the contrary references. Applicants recognize that a reference "is good for everything that it teaches," however this can be overridden by another conflicting reference, as the cases noted above hold. Applicants also submit that the facts of record regarding Osamu '172 following Osamu '374 in application date and Osamu '172 being completely contrary to Osamu '374, is sufficient evidence that the very same inventors of Osamu '374 decided that Osamu '374 was not the way to approach the problem. Instead the problem was later addressed in Osamu '172 by the very same inventors in a completely contrary manner to that suggested in Osamu '374.

Applicants submit that this evidence is true regardless of Osamu '172 not specifically saying the technique of Osamu '374 "is to be avoided." This is not *Young, supra*, where a stranger criticized the earlier reference. This is the same inventive entity abandoning one approach for a totally contrary approach. The facts in the record indicate that Osamu '374 was first filed, the totally contrary Osamu '172 was later filed by about five months, the later filed Osamu '172 issued as a patent in 1997, over six years ago, and Osamu '374 has not issued as a patent.

The above facts constitute evidence of the second reference teaching away from the first and it is now the requirement for the Examiner to put in the record some evidence as to why this evidence is not sufficient to show the later reference teaches away from the first. *In re Lee*, 277 F.3d 1338, 1345, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) ("'deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense."' The Board's findings must extend to all material facts and must be

documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability."); *In re Thrift*, 298 F.3d 1357, 1364, 63 U.S.P.Q.2d 2002 (Fed. Cir. 2002) ("the Board's reliance on 'common knowledge and common sense' did not fulfill the agency's obligation to cite references to support its conclusions ... the Board must document its reasoning on the record to allow accountability. This documentation also allows effective judicial review." *citing, Lee* at 1344-45)

For the above stated reasons Applicants submit that the subsequent approach of the inventors in Osamu '172 teaches that the prior effort (of the '374 application) was viewed by the very same inventors as a failed effort. Instead, the '172 patent teaches the approach which the inventors adopted which forces gas flow against the rear of a diffraction grating. Accordingly, when the circumstances in their entirety are evaluated Applicants urge that any teachings of the '374 application were abandoned as unworkable and, thus, one of ordinary skill when viewing the efforts of these inventors would not of been taught to practice the invention as recited in claim 46. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §102 of claim 46 are respectfully requested.

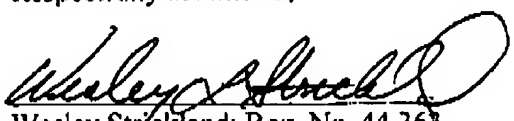
Claims 16, 17, 47, and 48 stand rejected under 35 USC §103 as unpatentable over Osamu. The Examiner admits that Osamu does not explicitly disclose setting a gas flow at the rates recited in these dependent claims but asserts that discovering the optimum value of the gas flow rate involves only routine skill. In stating this rejection, the Examiner has selectively quoted only portions of the decision *In re Boesch* and has ignored a key element in that Court's decision. In particular, for the optimization of a particular parameter to be characterized as routine experimentation, that parameter "must first be recognized as a result-effective variable." If the parameter optimized was not recognized in the prior art to be a result-effective variable, then the determination of optimum or workable ranges may not be characterized as routine experimentation. Applicants urge that the prior art fails to recognize that the flow rate of the gas flowing over a grating is a result-effective variable. Thus, claims which identify particular ranges of gas flow rates across a grating do not recite obvious subject matter. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §103 of claims 16, 17, 47, and 48 are respectfully requested.

Claims 18-38 and 44 stand rejected under 35 USC 103 as unpatentable over Algots (US 6,192,064) in view of Osamu. Claims 39, 40, 45, and 49 stand rejected under 35 USC §103 as unpatentable over Algots in view of two different patents of Osamu. The present application is a continuation of an earlier filed application and, therefore, has a priority date of at least November 17, 2000. The patent to Algots et al. issued February 20, 2001 and, therefore, only qualifies as prior art under 35 USC §102(e). The subject matter of the Algots et al. patent and the presently claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Accordingly, the Algots et al. patent cannot be used to preclude patentability under 35 USC §103. Reconsideration and withdrawal of the rejection under 35 USC §103 of claims 18-40, 44, 45, and 49 are respectfully requested.

In view of the above remarks and amendments, Applicants believe claims 15-49 are in condition for allowance and passage of this case to issue is respectfully solicited.

Applicants authorize the Commissioner to charge our Deposit Account No. 03-4060 in the amount of $450.00 for the two-month extension of time fee. Applicants do not believe any other fees are due, however if any other fees are due the Commissioner is authorized to charge our Deposit Account the appropriate amount.

Respectfully submitted,



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